REMARKS

Applicant has carefully reviewed and considered the Office Action mailed on July 16, 2003, and the references cited therewith.

No claims are amended, cancelled, or added; as a result, claims 1-21 are now pending in this application.

§103 Rejection of the Claims

Claims 1, 2, 7, 8 and 16-21 were rejected under 35 USC § 103(a) as being unpatentable over Adams (U.S. 5,963,944) in view of Meyer et al. (U.S. 6,289,378).

Adams describes a system and method in which autonomous agents move independently among computers to index data, replicate data, and manage the size and content of data files stored on networked systems. Although Adams teaches for example specifying a preferred state of data file sizes in systems, it does not teach many other elements of the present claims, including specifying a preferred state of the networked computer system, particularly where the preferred state comprises hardware and software configuration as is recited in the pending claims, but merely addresses distributed data management.

The present Office Action states that the claimed specifying a preferred state of a networked computer is met by Adams (col. 9, ln. 46-50). The cited section, along with col. 3, ln. 65 - col. 4, ln. 7, describe examination of a data index file to determine whether it exceeds a maximum value, and splitting the index file among multiple nodes if the maximum value is exceeded. It does not address a subject relating to specification of a preferred state of a networked computer itself, or more specifically to specification of a preferred hardware or software configuration, as is recited in the pending claims. Reliance upon this to provide motivation for combination with other references is therefore also insufficient, as is explained later in greater detail.

It is further argued that the claimed defining of selected networked computers to be maintained in such a preferred state is anticipated by Adams (col. 5, ln. 3-15). This cited section of Adams describes how memory stores data used by agents in determining actions at a node,

which includes indicating which other nodes are likely to contain index files of a certain type that are candidates for aggregation. It does not comprise a list of computers to be maintained in a specified preferred state, but describes only other nodes likely to have index data similar to the present node.

Adams is again cited (col. 2, ln. 30-40) to show anticipation of the claimed monitoring the selected networked computers for deviation from the preferred state. The cited section of Adams again fails to discuss the relevant element of the pending claims, even ignoring the lack of previous definition of such a preferred state of a computerized system or selection of networked computers. This section of Adams simply discusses use of uncoordinated autonomous agents to provide a scalable, decentralized system for managing data and index distributed among network nodes. It does not address monitoring the state of the nodes for any particular state or for any other purpose.

Finally, Adams is cited (col. 3, ln. 65 – col. 4, ln. 7) as teaching the claimed bringing selected networked computers that deviate from the preferred state to the preferred state via the mobile software agent that travels autonomously between computers. The cited section teaches splitting an index file that exceeds a maximum size among multiple nodes, and fails to address selected computers, specification of a preferred hardware or software configuration, monitoring selected computers for deviation from the specified hardware or software configuration, or bringing those selected networked computers deviating from a preferred hardware or software configuration state to the preferred hardware or software configuration state.

The cited Meyer reference discloses a computer management system that uses an agent on a computer system to provide management of various settings on the computer using a web browser or other remote configuration access program. Meyer fails to discuss any other aspect of the pending claims, including defining selected networked computers to be maintained in the preferred state as is recited in the pending claims.

Besides lacking the claimed features of the present invention in combination, the combination of Meyer and Adams lacks the required motivation to combine in the references themselves. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re*

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE
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Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). Here, the present Office Action intentionally misreads the claimed specifying a hardware or software configuration of a networked computer as equivalent to specifying a preferred index data file size, and uses this as the sole link between Adams and Meyer. As discussed above in greater detail, Adams and Meyer are directed toward different tasks, and nowhere explicitly suggest combination with one another or reasonably suggest the success of such combination.

Further, the fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01. The prior art does not suggest desirability of combination, or otherwise contemplate the present invention. The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reasons for the worker in the art, without the benefit of the specification, to make the necessary changes in the reference device. *Ex parte Chicago Rawhide MFG. Co.*, 223 USPQ 351, 353 (Bd. Pat. Ap. & Inter. 1984). MPEP § 2144.05(VI)B.

Because the cited art fails in combination to teach various elements of the pending claims, such as defining selected networked computers to be maintained in the preferred state and other such elements as described in greater detail above, the claims are believed to be in condition for allowance. Further, combination of the cited references has been shown to be improper for the various reasons given above. Applicant therefore believes the pending claims are in condition for allowance, and respectfully requests reexamination and allowance of the pending claims 1, 2, 7, 8 and 16-21.

Claims 3-6 and 10-15 were rejected under 35 USC § 103(a) as being unpatentable over Adams and Meyer et al. in view of Walsh (U.S. 6,233,601). Also, claim 9 was rejected under 35 USC § 103(a) as being unpatentable over Adams and Walsh in view of Johnson et al. (U.S. 5,987,135).

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Applicant incorporates the above discussion of Adams and Meyer by reference, and points out that these claims are further in condition for allowance as dependent from base claims shown above to be in condition for allowance.

Applicant therefore respectfully requests reexamination and allowance of these claims 3-6 and 9-15.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9581 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.
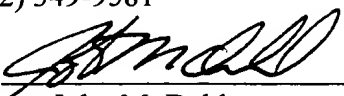
Respectfully submitted,

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Date _Sep. 16 03_

By _____
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this _16_ day of September, 2003

Emily Bates
Name

Signature